

REMARKS/ARGUMENTS

This application has been carefully reviewed in light of the October 6, 2004 Office Action. In response, Applicant provides the following arguments in support of the patentability of the claims of the present invention, and respectfully request reconsideration and reexamination of the application, as amended.

PRIORITY

The Examiner asserted that the limitation of "substantially the entire body" is not disclosed in the provisional application, thus Applicant's priority to provisional application serial no. 60/163,879 is acknowledged but lacks proper written description in support of this recitation. Applicant respectfully disagrees with this assertion. First, it will be well known in the course event photography business that the entire body or substantially the entire body of the event participant will be photographed as only these photographs are valuable to the event participant as a memento or keepsake of the event. To assert otherwise is simply ludicrous. Thus, Applicant respectfully submits that "one of skill in the art" would readily understand this limitation inherently without the specific language stated in the application.

Moreover, "event photography" by definition suggests the entire body where participant is captured via photograph. The provisional application states "the identifying markings would . . . because one event participant obscured the markings of another." This disclosure in the provisional application suggests that the pictures are taken of the entire participant or participants - not only portions of their bodies. The statement in the provisional "pictures of non-identifiable event participants [because bib numbers were not visible]" also suggests the entire participant and not only portions of their body is photographed.

Accordingly, while it may be convenient for the Examiner to simply state that the entire event participant is not photographed in order to find references such as Sigel et al. and Imhof that show photo-finished

systems wherein only portions of the body are sequentially photographed in order to determine the winner of a close race, this is simply inappropriate and a classic case of hindsight reasoning in a futile attempt to reject the present application.

CLAIM REJECTIONS

Claims 1, 51, 59, and 64 were rejected under 35 U.S.C. §112, based upon the assertion that the claims contain subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The claims recite the limitation "... substantially the entire body....". This limitation, asserts the Examiner lacks written description in the specification.

Once again, Applicant respectfully disagrees with this assertion. The title of the invention "A PROCESS FOR PROVIDING EVENT PHOTOGRAPHS FOR INSPECTION, SELECTION AND DISTRIBUTION VIA A COMPUTER NETWORK" implies that the event photographs are inspected and selected by the event participants. The obvious question is: Why would an event participant want a photograph of a fraction of his or her body? On page 4 of the Detailed Description of Preferred Embodiments section of the Application, it is stated that pictures of participants of these events are taken during the event. For example, a picture of each participant of a race, such as a marathon, may be taken at the finish line. Pictures may also be taken during the course of the event or during celebrations after the event. Applicant submits that it would be abundantly clear to anyone skilled in the art that such photographs are of the entire event participant, or substantially the entire body of the event participant, and not a fraction of the event participant's body as in photo-finish systems. The application also discusses estimating algorithms made available to the event participant to locate his or her picture. Such algorithms are based on minutes, and not seconds or fraction of a second. This is further evidenced that the entire body of

the event participant, and not a photo-finish or partial photograph is taken.

The application discusses in great detail how an event participant logs onto a web-site to find and select the picture to be electronically transferred, printed by the customer, or printed at the host on photographic paper or the like so as to be produced in high resolution and in a variety of sizes, such as 8 ½" by 11". Once again, it defies reasoning that an event participant would be interested in going to such length and paying money for a picture of his or her finger, hand, portion of head, etc.

Accordingly, Applicant respectfully traverses this rejection, as well as the aforementioned Priority Statement, and requests that the Examiner consider each of these claims as written and fully supported within the application and by those skilled in the art in a manner necessary to properly examine this application.

Claims 1, 3, 14, 15, 17, 18-20, 51-58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Imhof (U.S. Patent No. 5,103,433) in view of Narayanaswami et al. (U.S. Pat No. 6,504,571 B1), and further in view of an "Official Notice".

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991).

As discussed in Applicant's previously filed Supplemental Declaration, traditional sporting event photography involved multiple steps at great cost to the photographer. Pictures were taken, the negatives or photos developed and reviewed for bib numbers, the bib

numbers cross-referenced with a listing provided by the event sponsor, paper order forms were mailed to the event participants that were able to be identified which included a thumbnail print, and then the event participant viewing the thumbnail print might elect to purchase one or more photographs by filling out a paper order form (or in some instances an on-line order form) and provide a check or credit card number for payment. As explained by Mr. Wolf, this process was incredibly time consuming and expensive, especially considering that not all of the event participants purchase photographs. Until Applicant's invention, no sporting event photograph service provided on-line photographs for viewing, inspection and purchase. As explained by Mr. Wolf, the primary reason behind this was that it was not feasible as the event participants would be required to view hundreds or thousands of photographs in order to find their particular photograph and determine if they wanted to order it.

Imhof teaches a preferred method of taking pictures every 0.25 seconds or four frames per second. Similar to Sigel et al., this is a photo-finish invention, and not a sport event photography invention, as disclosed and recited in the present application. Imhof teaches away from using still cameras (col. 2, Ins. 35-60) and prefers the use of video cameras (col. 5, Ins. 64-68). The present invention makes no reference to video cameras and recorders, but instead uses a still camera to capture single images. Moreover, Imhof teaches a timestamp be placed on video image frame (bottom right corner of item 28) - see FIG. 3 (i.e., 11:99 and 12:01). This means that this time stamp is interpreted as eleven seconds and ninety-nine/one hundred seconds, not minutes and seconds. There is no mention or suggestion of including a digital time stamp in the recorded digital frame. The present invention does not place a time stamp on the image itself, but the time stamp is associated with the digital data comprising an image file. Typically, the image itself is the only thing that is printed, and not the time stamp which is contrary to what Imhof teaches.

With respect to the photo-finish time keeping of Imhof, this is a relative time which is associated with the picture from the event start to

the time the winner crosses the finish line. The present invention teaches an absolute time of the day to be associated with the photograph. For example, the present invention uses hours and minutes of the day, such as 10:45 a.m., whereas Imhof would teach a relative time of e.g., 10:99, which is ten seconds and ninety-nine/hundred seconds, which could be the result of a hundred yard-finisher from start to finish in the 100 yard dash race.

Imhof was filed in 1988 and it was well known that analog video cameras were of very low resolution at the time. Such recording devices are not suitable for still photography or event photography.

Contrary to the assertions by the Examiner on page 3 of the Office Action, Imhof does not take photographs of substantially the entire body of at least one participant of a sporting event along at least one point of a course or field thereof. Instead, as clearly shown in FIGS. 1, 3, 4 and 6, Imhof is directed to a photo-finish sequential pictures which are taken at intervals of 1/25 seconds by pulling at least one electronic detector.

The Examiner correctly states that Imhof does not teach informing the sporting participants of the identifying data, transferring the data to computer network server, cataloging each of the photographs on a web-site server according to the identifying data, accessing the server location other than the sporting event and searching for a photograph of a particular sporting event participant utilizing the identifying data."

However, the Examiner's assertion that Imhof teaches that his invention includes a computer connected between the camera and printer to process images received from the camera, and therefore, Imhof's invention converts the pictures received from the camera into digital format otherwise the computer would not be able to perform the process as disclosed in Imhof's specification, is erroneous. The microprocessor between Imhof's camera (6) and printer (12) of FIG. 1, does not suggest or imply to someone knowledgeable in the art that the image is digitized. Instead, the microprocessor described simply automates the calculation of average speed of the participants (col. 13, ln. 24).

The Examiner combines Imhof with Narayanaswami et al., stating that Narayanaswami et al. teaches accessing a remote server and searching for a photograph utilizing the identifying data, such as date and time, and therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Narayanaswami et al. into the method of Imhof. This assertion is based on the motivation that one of ordinary skill would have done so in order to form an efficient search and retrieval digital image is stored in remote servers as taught by Narayanaswami et al. However, as discussed above, Imhof does not teach the digitizing of the images. Moreover, there is no discussion whatsoever, in either reference to support the motivation proposed by the Examiner. Imhof makes no mention whatsoever that the images (analog or digital) would be filed in the data base. Narayanaswami et al. makes no mention of sporting event photography, but simply teaches a method of cataloging and searching digitally recorded images. Applicant respectfully asserts that the motivation from Narayanaswami et al. references simply is not there. As the photo-finish pictures of Imhof take place over the matter of seconds, there is no need for an elaborate system for searching and retrieving such recorded images. Instead, the images are merely rewound and viewed to determine the first place finisher, and the time of finish for each participant.

In Ruiz v A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), it was held that "while the references need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability must be "clear and particular." In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. [Emphasis added]. In the instant office action, the showing of combinability is far from "clear and particular."

"For a proper obviousness combination, the prior art references must provide a suggestion or motivation to make such a combination." Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.,

21 F.3d 168, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) citing Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 934 15 USPQ2d 1321, 1323 (Fed. Cir. 1990).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* Applicant respectfully asserts that the references have not been properly combined as the references do not provide nor suggest the motivation to make such a combination in a clear and particular manner.

It is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. Life Technologies, Inc. v. Clontech Laboratories, Inc., 56 USPQ 2d 1186 (Fed. Cir. 2000). Of course, the Examiner cannot use Applicant's claims as a framework from which to pick and choose among individual references to recreate the claimed invention as such hindsight is impermissible and strictly forbidden. Applicant believes that the Examiner has improperly used Applicant's claims as a framework from which to pick and choose among the Narayanaswami et al. and Imhof references in an attempt to reject the claims of the application - which is strictly forbidden.

The Examiner has admitted that Imhof and Narayanaswami et al. do not teach a web-site server or order any images. Thus, the Examiner falls back on the "Official Notice" that "it is old and well known in the art to use a web-site and to place an order through a web-site. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the cited prior art. One of ordinary skill in the art would have been motivated to do so to

exploit the power of the World Wide Web for commercial purposes". First, Applicant traverses this rejection on the basis that there is not a reference supporting this bold assertion dating back to the time period before Applicant's invention. Second, Applicant traverses this rejection as in 1999, when the Application was filed, it was not well known in the art to fulfill a customer's order via electronic transfer, and particularly not for event photography. In fact, the reference previously cited by the Examiner (Runner's World, Daily News, October 1999), supports the novelty of ordering on-line in 1999 by stating "using the information on the proof card, you can place your order on-line rather than sending back the card. We predict that the next step will be getting the proofs on-line." Thus, it is evident that in late 1999 orders were not obtained on-line for event photography. Instead, it was projected and speculated that in the future this would be done. Of course, the date of invention, as discussed in previous responses, pre-date this October 1999 reference. Thus, Applicant asserts that the "old and well known" "Official Notice" was simply not true at that time.

With respect to the assertions on page 7 of the Office Action, that neither Imhof nor Narayanaswami et al. explicitly teach the step of posting identifying data associated with each photograph, Applicant agrees, but disagrees with the bold assertion that it would have been obvious to incorporate this teaching into the method of Imhof. Imhof simply does not disclose nor suggest this step and to conveniently assert that it would have been obvious to do so arises to an improper examination of the Application.

The Examiner correctly states that Narayanaswami et al. does not explicitly disclose searching based on an approximate time. This is correct. However, the Examiner's assertion that it would have been obvious to do so has absolutely no merit or basis.

On page 7 of the Office Action, the Examiner asserted that conditional statements such as "when" and "can" render these claims conditional and thus claims 15 and 54 optional as they do need not be performed. Applicant has amended claims 14 and 53 so as to replace

"can be" with the term "is" which is definite and not conditional. Thus claims, 14, 15, 53 and 54 should be reexamined on this basis.

The improper combination of Imhof and Narayanaswami et al. fail to teach or suggest all of the claim limitations. Thus, even this improper combination fails to render the claims unpatentable.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970). The improper combination of Imhof and Narayanaswami et al. fail to teach or suggest all of the claim limitations. Thus, even this improper combination fails to render the claims unpatentable.

Claims 1, 3, 6-12, 17 and 59-75 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sigel et al. (U.S. Patent No. 6,545,705) in view of Narayanaswami et al. Applicant respectfully traverses these rejections.

Sigel, similar to Imhof is directed to a photo-finish system, as shown in FIGS. 2 and 3. In the Summary of the Invention, Sigel discloses that the system is aimed at image objects crossing a line of interest, wherein the camera time-sequentially captured the object by imaging it onto array of detector elements and converting the sample signature into a digital line image or frame, or period. Thus, Sigel does not teach a process for taking photographs of substantially of the entire body of one participant of a sporting event along at least one point of a course or field thereof. Instead, the Sigel reference takes multiple photographs of only portions of the participant's body, which is worthless in event photography as a memento or keepsake of the event - as anyone of ordinary or even low skill in the art would clearly recognize. Sigel, in fact, is in no way directed to a process for providing event photographs of race participants for inspection, selection and distribution. As such, Sigel, similar to Imhof, is completely non-analogous to the present invention.

The Examiner correctly states that Sigel does not explicitly disclose and inform the participants of the identifying data. Contrary to the Examiner's assertion, this limitation is not inherent in a process of Sigel (even though Sigel discloses that contestants may have a number on his or her jersey) as the images are not intended to be used by the participants, but instead by others such as judges of a race, etc.

In an attempt to overcome the shortcomings of the Sigel reference as compared to the present invention, the Examiner has combined Narayanaswami et al. with Sigel. However, neither of these patents make any reference to event photography in the context of the present invention. There is no motivation to combine Sigel nor Narayanaswami et al. without knowledge of the present invention's disclosure, and thus the motivation is improper.

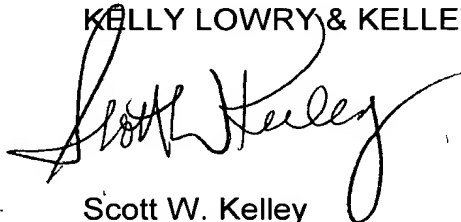
Moreover, Narayanaswami et al. actually teaches away from the present invention. The present invention teaches the association of date and time with each digital image to achieve the novel features taught by the present invention and solves the heretofore cumbersome event photography constraints. Narayanaswami et al. in column 2, lines 20-25, teaches that "recording time and date with each image provides an insufficient number of parameters . . . for purposes of efficient database querying." Thus, Narayanaswami et al. actually teaches away from the present invention core premise, i.e., associating data and time with the digital images allowing efficient cataloging of images and overcoming heretofore cumbersome event photography constraints. Thus, the Narayanaswami et al. reference actually teaches away from the assertion and the primary purpose for combining Narayanaswami et al. with Imhof and Sigel to arrive at the present invention. This is a fatal flaw in the combination of the references in rejection of the presently pending claims.

The other shortcomings of Narayanaswami et al. and Sigel are similar to that of Imhof in that the Official Notices are not well-founded and baseless, and even incorrect, as described above. It is apparent that the Examiner has taken Applicant's disclosure and claims and used these

as a basis to pick and choose among individual references in an attempt to combine these references in rejecting Applicant's claims. Such hindsight and reasoning is strictly forbidden. Moreover, the combined references fail to suggest or teach all of the claim limitations of the claims of the present application. Thus, Applicant respectfully submits, the combination of these references is improper, and has failed to establish unpatentability of the claims of the present Application. Accordingly, each of the pending claims 1, 3, 6-12, 14, 15, 17-20 and 51-75 is in condition for allowance, notice of which is requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Scott W. Kelley", written over the printed name.

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